



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DANIEL R MCCLURE
THOMAS KAYDEN HORSTEMEYER & RISLEY
SUITE 1500
100 GALLERIA PARKWAY NW
ATLANTA GA 30339

COPY MAILED

JUN 02 2008

OFFICE OF PETITIONS

In re Patent No. 5,974,528 :
Issue Date: October 26, 1999 :
Application No. 09/111,305 :
Filed: July 7, 1998 :
Attorney Docket No: 252302-1100 :

ON PETITION

This is a decision on the petition filed March 4, 2008, under 37 CFR 1.378(b), to accept the delayed payment of the maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400.00 as set forth in 37 CFR 1.17(f). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

The patent issued October 26, 1999. The first maintenance fee due could have been paid during the period from October 28, 2002 through April 28, 2003 or with a surcharge during the period from April 29, 2003 through October 26, 2003. The second maintenance fee could have been paid during the period from October 26, 2006 through April 26, 2007 or with a surcharge during the period from April 27, 2007 through October 26, 2007. This patent expired on October 26, 2003 for failure to timely remit the maintenance fee.

A petition to accept the delayed maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate, verified showing that the delay was unavoidable, since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(l)(1).

The Commissioner may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable".¹ A late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses identical language (i.e. "unavoidable delay").² Decisions reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.³ In this regard:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.⁴

Petitioner asserts that the delay was unavoidable because of the "PTO's undue delay and piecemeal examination in a co-pending reissue application, as well as a nearly three year delay at the U.S. PTO to report the status of the co-pending reissue application, despite repeated status inquiries and petitions from the undersigned attorney."

This petition lacks item (1) above.

Petitioner's arguments have been considered but are not persuasive. At the outset, the filing of a reissue application does not alter the schedule of payments of maintenance fees on the original patent. If maintenance fees have not been paid on the original patent as

¹35 U.S.C. § 41(c)(1).

²Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1989)).

³Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used by prudent and careful men in relation to their most important business").

⁴In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

required by 35 U.S.C. 41(b) and 37 CFR 1.20, and the patent has expired, no reissue patent can be granted. 35 U.S.C. 251, first paragraph, only authorizes the granting of a reissue patent for the unexpired term of the original patent. Once a patent has expired, the Director of the USPTO no longer has the authority under 35 U.S.C. 251 to reissue the patent. See *In re Morgan*, 990 F.2d 1230, 26 USPQ2d 1392 (Fed. Cir. 1993). The time for prosecution of the reissue application has no correlation to the original patent as it relates to the payment of the maintenance fees.

As 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.⁵ That is, an adequate showing that the delay was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent.⁶

No evidence has been provided to establish that the delay by the "third party" firm charged with payment of the maintenance fee was unavoidable. Especially since petitioner notes that the "third party" firm charged with the responsibility to pay the maintenance fees felt no reminders were necessary, that they would "handle" payment of the maintenance fees and further that all reminders were removed from the docket of the attorneys of record. Petitioner is reminded that in the absence of an adequate showing of the diligence of their representatives in this matter throughout the period in question, the actions or inactions of those responsible for paying the maintenance fees will remain imputed to the inventors.⁷ Petitioners therefore have not shown unavoidable delay. The showing of record is inadequate to establish that the delay in timely paying the maintenance fees was unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

It is incumbent upon the petitioner to demonstrate, via a documented showing, that the entire delay was unavoidable which would include from the time the maintenance fee was due until the time petitioners became aware that the maintenance fee had not been paid, as well as from that point until the filing of the instant petition.

Any showing of unavoidable delay must include a statement from the principals responsible for payment of the maintenance fees as to why action was not taken to timely submit the required maintenance fee while the patent was under their control.

⁵Ray, 55 F.3d at 609, 34 USPQ2d at 1788.

⁶Id.

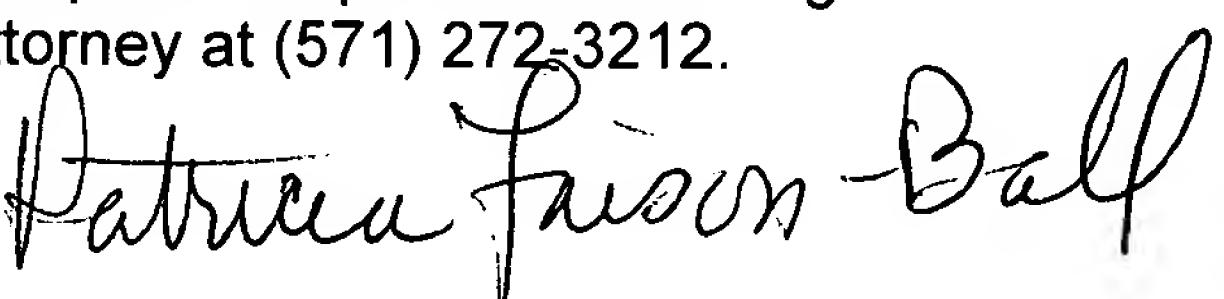
⁷See In re Lonardo, 17 USPQ2d 1455 (Comm'r Pat. 1990).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
 Commissioner for Patents
 P.O. Box 1450
 Alexandria VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.


Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions